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EXAMINER	
FISCHER, ANDREW J	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL A. CRONCE

Appeal 2009-002343
Application 10/072,597
Technology Center 3600

Decided: August 10, 2009

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and BIBHU R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-26 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We REVERSE.

THE INVENTION

The Appellants' claimed invention is directed to the delivery of secure software licensing information to authorize the use of a software product. The system comprises a computer system for using the software product, an authorizing program, and a license server connected to the computer system over a network. The method includes generating a license request containing user and product information signed by a private product key (Spec 3:21-4:5). Claim 1, reproduced below, is representative of the subject matter of appeal.

> 1. A method for the delivery of secure software license information to authorize use of a software product, the method comprising the steps of:
>
> (a) associating with a software publisher a private and public key pair, wherein the software publisher provides the software product and includes a software program and an authorization program within the software product;
>
> (b) associating a product private key and public key with the software product, wherein at least one of the product private and public keys is digitally signed by the publisher private key, and

including the product private and public keys with the authorization program;

(c) upon invocation of the software product on a computer,
(i) generating by the authorization program a license request containing user and product information,
(ii) digitally signing the license request with the product private key, and
(iii) transferring the signed license request to a key authority,

(d) in response to the key authority receiving the signed license request,
(i) generating a license using data extracted from the license request and license terms,
(ii) signing the license with the publisher private key, and
(iii) transmitting the signed license to the authorizing program; and

(e) validating the signed license using the publisher public key, and using the license terms to control the use of the software product.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Venkatesan	US 6,898,706	May 24, 2005

The following rejections are before us for review:

1. Claims 1-26 are rejected under 35 U.S.C. § 102(e) as anticipated by Venkatesan.

THE ISSUE

At issue is whether the Appellants have shown that the Examiner erred in making the aforementioned rejections.

With regards to claims 1-23 this issue turns on whether Venkatesan discloses "upon invocation of the software product on a computer generating by the authorization program a license request."

With regards to claims 24-26 this issue turns on whether Venkatesan discloses "validating the software publisher who signed the license by comparing the publisher ID in the publisher certificate contained within the license with the publisher ID in the software product."

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:[1]

FF1. Venkatesan discloses a cryptographic technique for digital rights management (Title). A large number of identical watermarks are embedded in a software object. The user downloads the software object and transacts with the publisher to obtain an electronic license signed by the publisher to an enforcer that is located in the client computer. (Abstract).

FF2. Venkatesan discloses that, "Once a user has downloaded a watermarked object, then, in order to use that object, the user, through his(her) client PC, electronically transacts, through Internet 30 and links 310 and 323, with publisher's web server 335. Specifically, in return for payment of a specific licensing fee to the publisher, web server 335 downloads to the client PC an electronic license (L), cryptographically signed by the publisher to an "enforcer" located in that PC." Col. 14:35-45.

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[1] *See Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

FF3. Venkatesan in Col. 14:53-54 discloses that the enforcer has active objects such as executable programs and that the enforcer can reside "in an operating system itself executing in the client PC."

FF4. Venkatesan in Col. 14:52-54 does not disclose that when the software program is invoked that it obtains a license by creating a license request.

FF5. Venkatesan in Col. 20:9-14 does not disclose that the enforcer resides on the software program. Venkatesan discloses that the enforcer is located with the operating system of the PC (Col. 18:52-57, Fig. 4).

FF6. Venkatesan in Col. 19:25-56 discloses an authenticated boot process to assure its own security and chains of trust.

FF7. Venkatesan in Col. 19:25-56 does not disclose that there is validating of the software publisher who signed the license by comparing, the publisher ID in the publisher certificate contained within the license, with the publisher ID in the software product.

PRINCIPLES OF LAW

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their "broadest reasonable construction" in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

ANALYSIS

Claims 1-23

The Appellant argues that the rejection of claims 1, 12, and 16 is improper because Venkatesan fails to disclose "a software program and an authorization program within the software" and where "upon invocation of the software product on a computer," the authorization program generates "a license request" as recited in the claims. Brief 15. The Appellant argues that Venkatesan discloses that "the user" initiates the license request with the publisher through the client PC. Brief 15. The Appellant also argues that in Venkatesan that the "enforcer" which looks for watermarks in an object cannot be considered to the "authorization program" because the enforcer program is not part of the protected software object. Brief 15-16.

In contrast the Examiner has determined that Venkatesan has disclosed the cited claim limitations. The Examiner has determined that the cited claim language makes no reference to a software object that has been downloaded to a client PC to generate a license request. Answer 9. Regardless, the Examiner has determined that Venkatesan discloses this feature at Col. 11:14-41 and Col. 14:52-54. The Examiner has also determined that the "enforcer" of Venkatesan is analogous to the claimed authorization program. Answer 10.

We agree with the Appellants. Claim 1 specifically requires that "upon invocation of the software product on a computer…generating by the authorization program a license request." Brief 15. Thus the claim specifically requires that when the software product is invoked, the authorization program generates a license request. In contrast Venkatesan discloses that once the user has downloaded the watermarked object that the

user through his or her client PC electronically transacts through the Internet 30 and links to the publisher's web server. In return for payment the client PC is downloaded an electronic license L to an "enforcer" located in that PC (FF2). Venkatesan in Col. 14:52-54 does disclose that the enforcer has active objects such as executable programs (FF3). However, this cited portion of Venkatesan does not disclose that when the software program is invoked that the authorization program obtains a license by creating a license request (FF4). In Venkatesan, it is the user that obtains the license (FF1), not the authorization program when the software program is invoked (FF4) as the claim requires. For these reasons, the rejection of claim 1 is not sustained. Claims 12 and 16 contain limitations similar to those in claim 1 and the rejection of these claims, as well as dependent claims 2-11, 13-15 and 17-23, is not sustained for these same reasons.

Claims 24-26

The Appellant argues that the rejection of claim 24 is improper because Venkatesan fails to disclose the limitation is step (c) iii which recites: "validating the software publisher who signed the license by comparing the publisher ID in the publisher certificate contained within the license with the publisher ID in the software product". Brief 9.

In contrast the Examiner has determined that Venkatesan discloses this limitation in Col. 19, lines 25-56. Answer 12. The Examiner also asserts that this limitation is disclosed "in the cited reference because without providing a cryptographic tie to the authority, software piracy and illegal access would be prevalent." Answer 12.

We agree with the Appellants. Venkatesan does disclose an authenticated boot process to assure its own security and chains of trust

(FF6). However, claim 24 requires more than just generic security or chains of trust and specifically requires "*validating the software publisher* who signed the license *by comparing the publisher ID in the publisher certificate contained within the license with the publisher ID in the software product*". The portion of Venkatesan cited by the Examiner does not specifically disclose that there is validation of the software publisher who signed the license by comparing the publisher ID in the publisher certificate contained within the license *with the publisher ID in the software product* (FF7) as the claim requires. Venkatesan has disclosed that the client PC is downloaded an electronic license L to an "enforcer" located in that PC (FF2) and it is not specifically disclosed that a publisher ID resides in the software product. For this reason, the rejection of claim 24 and dependent claims 25-26 is not sustained.

CONCLUSIONS OF LAW

We conclude that Appellants have shown that the Examiner erred in rejecting claims 1-26 under 35 U.S.C. § 102(b) as anticipated by Venkatesan.

DECISON

The Examiner's rejection of claims 1-26 is reversed.

REVERSED

APJ Initials:
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